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10/090,715	03/05/2002	Jitendra Patel	J6691/1(C)	9409

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UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,715

Applicant(s)

PATEL ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 & 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 1-30 are pending in this application.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of improper format. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2. Claim 2 objected to because of the following informalities:

Claim 2 is dependent on its self. Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Claims 1-12 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,3, 6-9,11,15,18-20 and 24 of copending Application No. 10/196130. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-30 provisionally rejected under the judicially created doctrine of double patenting over claims 1-28 of co-pending Application No. 10/196130, claims 1-38, of co-pending Application No. 10/034511, claims 1-23 of co-pending Application No. 10/096812, claims 1-34 of co-pending Application No. 10/034174 and claims 1-26 of co-pending Application No. 10/095657. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on these co-pending applications since the referenced co-pending applications and the instant application are claiming common subject matter, as follows: All claims are drawn to the similar methods for permanently dyeing hair using similar steps for applying similar mixture compositions of oxidative dye

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intermediates in a shampoo base at alkaline pH and oxidative compound in a shampoo base at acidic pH and wherein all sets of the claims recite similar conditioning agents presented in the compositions. The claims are differ only in that the instant claims recite a dyeing composition comprising at least two independent shampoo bases or conditioner bases .

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a method for dyeing hair by incorporating a dye composition that may comprise more than one shampoo base of conditioner base as conditioning agents because the co-pending applications teach similar methods for dyeing hair wherein the methods comprise the steps of applying to the hair dyeing compositions that comprise different conditioning agents such as fatty alcohol (structurant) (co-pending application No. 10/034511), fatty alcohols (co-pending application No. 10/095657), conditioning agents (shampoo base) (co-pending application No.10/034174) and conditioning agent of a gelling component (co-pending application No. 10/096812) thus, a person of the ordinary skill in the art would be motivated to select and choose more than one conditioning agent such as fatty alcohols, conditioner bases or gelling agents in the dyeing compositions as taught by the co-pending applications and would expect such a method to have similar properties and similar results to those claimed, absent, unexpected results.

Claim Rejections - 35 USC § 103

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-11 and 14-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US 5,376,146) in view of Lapidus et al. (US 4,104,021).

Casperson (US' 146) teaches a method for dyeing hair. The method comprises the step of contacting the hair with a mixture of a two part aqueous composition of a) an alkaline aqueous lotion containing from about 0.005% by weight to about 5% by weight (equimolar quantities of oxidation bases and couplers) of at least one primary intermediate such as para-phenylenediamine, from 0.005% to about 5% by weight of at least one coupler for the formation of oxidation dyes and 0.0% to about 5% of a propylene or hexylene glycol as a first conditioner base as claimed in claims 1-3, 10 and 30 (see col. 8, lines 30-34 and col. 9, lines 32-38) and b) an aqueous developer (oxidizing agent) comprising from about 0.5% by weight to about 40% of a peroxide oxidizer such as hydrogen peroxide as claimed in claims 8 and 11 (col. 3, lines 57-62, col. 9, lines 52-53 and claim 9) and quaternary ammonium salts as a second conditioner bases as claimed in claim 1 (see col. 8, lines 35-60). At the end of the coloring period the composition is washed from the hair with ordinary water as claimed (see col. 10, lines 64-66 and col. 11, lines 20-24).

The instant claims differ from the reference by reciting a method for dyeing hair comprising applying to the hair a dyeing composition for a number of treatments having a set time interval of about 8 hours and 30 days between each two consecutive such treatment as claimed.

Lapidus (US' 021) in analogous art of hair dyeing processes, teaches a process for dyeing hair comprising applying to the hair a mixture of a colorant-oxidative solution in successive applications for a time period up to 5 minutes and of substantially the same length for each

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subsequent application and wherein the application can be repeated once every 2 to 8 weeks (see col. 4, lines 45-63 and col. 7, claim 1).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the primary reference by incorporating the process for dyeing hair that involves successive applications to the hair as taught by Lapidus with reasonable expectation of success because Lapidus clearly teaches that dyeing hair with successive applications of dyeing composition in a short time period provided a deeper shades (see col. 2, lines 65-68 and col. 3, lines 1-4), and, thus, a person of ordinary skill in the art would be motivated to apply the dyeing composition with a successive applications to obtain a deeper shades of color and would expect such a process to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claim 5, it would have been obvious to one having ordinary skill in the art at the time the invention was made to contact the hair with the dyeing composition for a period of the claimed time because Lapidus teaches the application for a time period up to 5 minutes, which is a very short time period by conventional dyeing standard as taught by the reference (see col. 4, lines 47-49) and wherein the time period range is overlapping with the claimed range, and, thus, a person of the ordinary skill in the art would expect such a method to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claims 6 and 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply to the hair the dyeing composition in a number of treatments with the claimed time interval because Lapidus teaches that the desired interval, determined by the user (see col. 4, lines 51-52), and thus, a person of the ordinary skill

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in the art would be motivated to determine the time interval between each two consecutive treatments includes those claimed, and would expect such a method to have similar properties and similar results to those claimed, absent unexpected results.

With respect to claims 7, 14-30, it would have been obvious to one having ordinary skill in the art at the time the invention was made to evaluate the effect and results of the dyeing process on hair as claimed, because the combined references teaches hair dyeing compositions comprising similar dyeing ingredients such as shampoo and conditioner agents with similar concentrations wherein the compositions applied with similar process of successive application, and, thus, a person of ordinary skill in the art would expect such a process to have similar properties and similar results to those claimed, absent unexpected results.

5 Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US 5,376,146) in view of Lapidus et al. (US 4,104,021) and further in view of Duffer et al. (US 2001/0002254 A1).

The disclosures of Casperson (US' 146) and Lapidus (US' 021) are summarized above. The references fail to teach a method for dyeing hair comprising applying to the hair a dyeing composition comprising a volatile silicone as claimed.

However, the primary reference clearly teaches and suggests the use of the hair conditioners in the dyeing composition (see col. 8, lines 61-64).

Duffer (US' 254 A1) in another analogous art teaches a method for dyeing hair comprising applying to the hair a dyeing composition comprising 0.01 to 4% of volatile silicone (see page 3, paragraph 0067, page 4, paragraph 0079).

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Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of the primary reference by incorporating the volatile silicone as the conditioner agent as taught by Duffer for the reasonable expectation of success because the primary reference clearly teaches that conditioner agents are used in the hair dyeing composition, and, thus, a person of ordinary skill would expect such a process to have similar properties and similar results to those claimed, absent unexpected results.

7 Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US 5,376,146) in view of Yasuda et al. (EP 0 823 250 A2) and further in view of Duffer et al. (US 2001/0002254 A1).

Casperson (US' 146) teaches a mixture of a two part aqueous compositions of a) an alkaline aqueous lotion containing from about 0.005% by weight to about 5% by weight at least one primary intermediate such as para-phenylenediamine, 0.1% to about 5% of a monomeric quaternary ammonium compound as a conditioner base (see col. 8, lines 30-34 and col. 12, lines 3-4), and b) an aqueous developer (oxidizing agent) containing from about 0.5% by weight to about 40% of a peroxide oxidizer such as hydrogen peroxide (col. 3, lines 57-62, col. 9, lines 52-53 and claim 9), alkali soluble polymers of stearyl alcohol as a conditioner base (see col. 10, lines 23-24) and an amphoteric surfactant as claimed in claim 13 (see col. 3, line 68).

The instant claims differ from the reference by reciting a dyeing composition comprising 0.5 to 10% of fatty alcohol and 1% to 4% of a volatile silicone.

However, the reference teaches a dyeing composition comprising polymeric fatty

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alcohols such as cetearth-20 in the amount of 0.5% to 10% (see col.10 lines 15-33) and conditioning agent (see col. 8, line 63).

Yasuda (EP' 250) in analogous art of hair dyeing formulations, teaches a dyeing composition comprising 5.0% of high molecular weight fatty alcohol such as isotearyl alcohol as claimed (see page 6, Table 1).

Duffer (US' 254) in other analogous art of hair dyeing formulations teaches a composition comprising 0.0001 to 10% of silicone compound (see page 4, paragraph 0078).

Therefore, in view of teachings of the secondary references, one having ordinary skill in the art the time the invention was made, would be motivated to modify the primary reference of Casperson by incorporating the fatty alcohols and the volatile silicone as taught by Yasuda and Duffer to make such a composition with a reasonable expectation of success because the primary reference teaches the use of polymeric fatty alcohols (high molecular weight) in the hair dyeing composition to provide a suitable viscosity to the composition which remain on the hair for a sufficient period to achieve the desired hair coloring effect (see col. 3, lines 35- 39). Further, the primary reference teaches the use of hair conditioners in the composition (see col. 8, line 63), and, thus, a person of the ordinary skill in the art would be motivated to incorporate the high molecular weight of fatty alcohols and the volatile silicone as taught by Yasuda and Duffer to provide a dyeing composition with a appropriate viscosity in order to achieve the desired hair coloring effect, absent unexpected results.

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Conclusion

The newly presented references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217.

The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Eisa Elhilo
Patent Examiner
Art Unit 1751

October 26, 2003.